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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/227,593	01/08/99	BESSE	M 730.010US1
EXAMINER			

021186 IM62/0803  
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FORMER ART UNIT	PAPER NUMBER
	6

1721

DATE MAILED: 08/03/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

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## DETAILED ACTION

### *Specification*

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is no support in the specification for the proportions of claims 2, 3, 12 and 13, nor is there support for the language "chelating agent for divalent cations..."(claims 5 and 15).

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1, 4-9, 11 and 14-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-6, 14, 17-19 and 22 of copending Application No. 09/231,255. Although the conflicting claims are not identical, they are not patentably distinct from each other because the lubricant of 09/231,255 does not exclude the aryl phosphate of the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for alkyl and aryl alkoxyated phosphates, does not reasonably provide enablement for all alkyl and aryl phosphates. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The claims should be limited to the phosphates which are recited in the instant specification.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 6, 7, 10, 16, 17, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 6 and 16, the term "amine-type" is indefinite.

Claims 10 and 20 are rejected because it is not clear what is being claimed. The claims should set forth which materials are present in the base claims and which materials further comprise the base claims. In claim 10, it is not clear what is meant by the terms "5 EO units". Clarification is required.

Claims 7 and 17 are rejected because it is not clear what is being claimed. Clarification is required.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-6, 8-9, 11-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Despo (US 5,391,308) in view of Liu et al (5,244,589).

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Despo teaches an aqueous lubricant having utility as a conveyor lubricant. The lubricant comprises C<sub>8</sub>-C<sub>12</sub> alkyl alkoxyated phosphate, and C<sub>8</sub>-C<sub>10</sub> alkylaryl alkoxyated phosphates, sequestering agents (EDTA) and a metallic hydroxide (encompasses sodium hydroxide) (see abstract; col. 5, line 55 bridging col. 6, lines 1-50). Despo teaches the limitations of the claims other than the differences which are discussed below.

In the first aspect, Despo differs from the claims in that he does not specifically teach that the composition of his invention contains a quaternary ammonium antimicrobe agent. However, Liu teaches this difference in a similar composition (see abstract; col. 2, lines 42-56).

It would have been obvious to one of ordinary skill in the art to have included the quaternary compound of Liu in the composition of the Despo because Despo teaches aqueous conveyor lubricants and Liu teaches that lubricants of this nature obtain improved load bearing properties and excellent antimicrobial properties upon addition of the quaternary ammonium compound.


In the second aspect, the prior art differs from the claims in that it does not specifically teach the ratio of phosphate/quaternary ammonium compound. However, no unobviousness is seen in this difference because where the general conditions of the claims are disclosed in the prior art it is not inventive to determine the optimum amount of the components through routine experimentation.

In the third aspect, the prior art fails to teach the claimed pH of the lubricant. However, it would have been obvious to one of ordinary skill in the art to have selected the claimed pH range

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because where the general conditions of the claims are disclosed in the prior art it is not inventive to determine the optimum pH range through routine experimentation.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia Toomer whose telephone number is (703) 308-2509.



Cephia D. Toomer

Patent Examiner-1721

cdt/09227593.1

August 2, 1999